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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,519	07/13/2001	Satoshi Nakano	KON-1666	3475
20311	7590	01/28/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,519

Applicant(s)

NAKANO, SATOSHI

Examiner

Jordan M. Schwartz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11, 13, 15, 16, 18, 19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 13, 15, 16, 18, 19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-11, 13, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tucker patent number 6,102,539.

Tucker reads on these claims by disclosing the limitations therein including the following: an optical element (abstract, column 2, lines 44-54 with the most object lens of the laminate as the "optical element") comprising a base material consisting of a lens (column 2, lines 44-54 re the base material of this optical element consists of a lens); a surface layer formed on at least one of the surfaces (column 2, line 44 re "the adhesive" is between the lens elements and is therefore "formed on at least one of the surfaces" of the lenses and since it is formed on the surfaces of each of the lenses then it is a "surface layer"). Tucker further discloses that the adhesive layer includes a UV absorber to absorb substantially all radiation up to 400 nm (column 4, line 60) as well as the adhesive layer including a dye to provide selected transmission characteristics to reduce the transmission of light including the 420-680 nm range (column 3, line 14 and

Figures 1-2). Since the base material (the most object side lens) is not disclosed as absorbing radiation then the reflectance of the layer will inherently be less than the reflectance of the base material surface, this being based upon it being disclosed that the layer absorbs and reduces light transmission in light ranges that include 280-315 (i.e. "substantially all radiation up to 400nm") and 420-680 nm. Tucker further discloses the lens in an eyeglass (abstract). Since the layer is an adhesive between two lenses (abstract) then, in reference to the most object side lens of the laminate, the adhesive is formed on an image side surface (eye side surface) of this lens. Since the adhesive is minimizing light rays and is formed on the image side of the optical element, it will inherently minimize the rays entering from the image side of this lens. Furthermore, since it is an adhesive joining the two lenses then it will inherently be on the entire surface of this lens. The layered adhesive of Tucker would inherently include a substantially inorganic material, this being reasonably based upon Tucker disclosing that the layering can include a dye to impart the transmission characteristics (column 5, lines 11-37) and it is well known in the art of lenses that dyed lenses include the use of inorganic substances. It is believed that the adhesive of Tucker would inherently have the surface resistance as claimed, this being reasonably based upon the materials and method of forming the adhesive as set forth in Tucker. Tucker further discloses the lens including a polarizing film (column 5, lines 38-45). Therefore, the polarizing film can be considered the "base material" and it would be inherently providing the selective absorptivity as set forth in claims 8-9. Tucker further discloses the layering can have

plural layers (column 2, lines 55-67); and that the layer can comprise a conductive or metallic layer (column 5, line 20).

Claim 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahoroni et al patent number 5,225,244.

Ahoroni et al reads on this claim by disclosing the limitations therein including the following: an eyeglass comprising a lens (column 11, lines 43-68) comprising a base material consisting of a lens (column 11, line 43, the eyeglass lens as the base material, consisting of a lens); a surface layer formed on at least one of the surfaces (column 11, line 63 with the anti-reflectance coating as the "surface layer"); a lens holder (eyeglass lenses will inherently have a lens holder); a reflectance of a surface in a wavelength region of 420-680 nm , i.e. visible light, smaller than a reflectance of a surface of the base material (column 11, line 63 re the layer as antireflective and therefore the reflectance of the surface in the visible wavelengths will be less than that of the base material); the layer "formed on an eye side entire surface of the (lens) base material" (column 12, line 11 re applying the anti-reflection coating by either spin coating or dip coating will coat the entire lens and therefore will inherently coat the entire eye side surface of the lens). Since the image side surface of the ophthalmic lens will contain the anti-reflection layer, it will inherently minimize the rays entering from the image side of the lens. The luminous transmittance of the layer will inherently be 90% or more, this being reasonably based upon Ahoroni disclosing the lens for use in eyeglasses which, even with anti-reflection layers, inherently have large amounts of light transmittance.

Claim 19 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Marechal et al et al document number 2003/0179343.

Marechal et al reads on this claim by disclosing the limitations therein including the following: an eyeglass comprising a lens (paragraphs 001-002, 0013) comprising a base material consisting of a lens (paragraphs 001-002, 0013, the eyeglass lens as the base material, consisting of a lens); a surface layer formed on at least one of the surfaces (paragraphs 0006-0009, with the anti-reflection coating as the "surface layer"); a lens holder (eyeglass lenses will inherently have a lens holder); a reflectance of a surface in a wavelength region of 420-680 nm , i.e. visible light, smaller than a reflectance of a surface of the base material (paragraph 0008); the layer "formed on an eye side entire surface of the (lens) base material" (paragraph 0008 re coated on both sides of the lens). Since the image side surface of the ophthalmic lens will contain the antireflection layer, it will inherently minimize the rays entering from the image side of the lens. Marechal et al further discloses the layer comprising a transparent conductive layer containing indium oxide (paragraph 0006, 0078); the luminous transmittance of the layer as 90% or more (paragraphs 0006 and 0010). With respect to claim 23, the spectral transmittance of the layer for all light rays in the 400 to 700 nm range will inherently be 98% or more, this being reasonably based upon Marechal et al disclosing the layer as "highly transparent" (paragraph 0006) and disclosing that without tinting the transmittance will be higher, and with tinting, the transmittance can be as high as 95%.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker patent number 6,102,539.

Tucker discloses as is set forth above but discloses the adhesive on just one of the surfaces of the lens. However, it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive. Having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the luminous properties and differences in wavelengths between the two surfaces as set forth in claims 16 and 18 since it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive and having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18.

Prior Art Citations

Japanese documents 11-23804 and 11-258406 are being cited herein to show two additional references that would have read on claims 21-23 and possible claim 19,

however, such rejections would have been repetitive. White Jr et al patent number 5,619,288 would have read on at least claims 19 and 22, however, such rejections would have been repetitive.

Allowable Subject Matter

The allowability of claims 21-23 is withdrawn based upon the rejections set forth above.

Response to Arguments

Applicant's arguments filed September, 2003 have been considered but, with respect to the rejected claims set forth above, they are not persuasive. Applicant argues that Tucker discloses an adhesive formed between two lens elements and therefore does not disclose the base material "consisting of a lens". However, applicant is broadly claiming "an optical element" with the base material "consisting of a lens". Therefore, as stated in the rejection above, the most object side of the laminate lenses can be considered as the "optical element" and the material of this most object side lens can be considered as the "base material consisting of a lens".

Examiner's Comments

For applicant's information, in reference to claim 1, as a suggestion to overcome the above rejection by Tucker, the applicant might consider claiming in the preamble, "Eyeglasses" and in lines 9-10 claiming "the layer is formed on the most image side-entire surface of the eyeglasses" or, as a second suggestion, to claim in lines 2 and lines 10 of claim 1, "a base material consisting of a single, non-laminated lens element." and "is formed on an image side-entire surface of the single non-laminated

lens element...". As stated above, upon further consideration, claims 21-23 were rejected and, together with claim 19, are apparently broad due to the "in at least one of a wavelength region" language. Other references, as stated above, would have read on these claims. As a suggestion, for claims 19 and 21-23, applicant may want to consider changing the claim to state "in a wavelength region of 280 nm to 315 nm and in a wavelength region of 420 nm to 680 nm..." instead of claiming "in at least one of a wavelength region of...".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

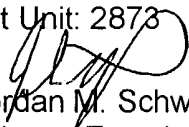
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Jordan M. Schwartz
Primary Examiner
Art Unit 2873
January 16, 2004